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EXAMINER

BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/997,713

Applicant(s)

FRIEDMAN ET AL.

Examiner

Raymond J. Bayerl

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 9, 12 - 18, 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 9, 12 - 18, 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ **NA - RB** Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution.

Applicant's 6 December 2004 response has introduced an apparent inadvertent renumbering of certain claims in the replacement claim text.

Misnumbered claims "11" – "19" have been renumbered as claims 12 – 20, respectively (see attachment).

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1 – 5, 8 – 9, 12 – 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Gupta et al. ("Gupta"; US #6,546,405 B2).

As per independent claim 1's "method" in which an "annotation file" is created for "a multimedia presentation", Gupta's ANNOTATING TEMPORALLY-DIMENSIONED MULTIMEDIA CONTENT is achieved when A human viewing temporally-dimensioned content will annotate, comment upon, and augment the multimedia document (Abstract). Thus, "identifying at least one desired portion" occurs (see also col 2, lines 13 – 35). The resulting annotation entry 300 is records "at least one pointer corresponding to the at least one desired portion" (col 10, line 65 – col 11, line 35), in an annotation collection 420 (the claimed "annotation file"; see also figs 3, 4).

As per "automatically presenting only one or more portions of the multimedia presentation identified as being desired", Gupta's multimedia document player (col 2, lines 36 – 48) is one in which a user can select a temporal annotation from a list, at which point the multimedia document player immediately proceeds to the presentation

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of the multimedia document at the particular relative time (col 2, lines 48 – 64). In this immediate procession, Gupta is “automatically” performing the function of going to the particular relative time, showing only what is annotated at that time, and “eliminating any other portions of the multimedia presentation”.

As per claim 2’s “creating” and “playing the recorded program file” (see also claim 9), this is a function related to Gupta’s multimedia document player. The content in Gupta must be originally created and retained. Then, when the multimedia document player immediately proceeds to the presentation at the particular relative time, “only the at least one desired portion...is displayed...automatically”.

The application of “a predetermined set of criteria” in “identifying at least one desired portion” (claims 3, 14) reads upon Gupta’s identical teaching that The user can select temporal annotations which satisfy various criteria for inclusion in the display of the multimedia document (col 2, lines 48 – 54), these being “based upon a preference of an individual viewer” (claims 4, 15), such as a particular date.

Claim 5’s “annotation file” that “further contains: information related to the at least one desired portion” (see also claims 12, 16) reads upon the inclusion of user authored content in content field 310 of a Gupta temporal annotation entry 300 (col 4, lines 52 – 63).

Independent claim 8 is similar to claim 2 as treated above, and is anticipated by Gupta, who teaches “creating an annotation file” in collection 420, and “applying the annotation file” to render “one or more desired portions” “automatically” by the multimedia document player according to various criteria for inclusion.

Independent claim 13's use of "a recorded program file" reads upon Gupta's storage of the original Multimedia document 140, which can alternatively be a motion video or audio file (col 4, lines 28 – 51). In handling the collection 420, Gupta uses "an annotation management software" so that "a display device displays only one or more desired portions", as noted above with respect to Gupta's multimedia document player.

The overall collection 420 in Gupta's annotation database will have "information related to a portion...other than the at least one desired portion" (claim 17), since annotations to portions other than those satisfying criteria are included.

4. Claims 6 – 7; 18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Kelly et al. ("Kelly"; US #5,907,322 A).

As per independent claim 6's "broadcasting an event" and "identifying at least one desired portion of the event", Gupta does not contain **explicit** teachings of such a mode of transmission, being more concerned with what happens at the site of the multimedia document player itself. However, Kelly's TELEVISION EVENT MARKING SYSTEM allows for bookmarking viewer selected TV broadcast events (Abstract), and storing a set of event-identifier data associated with the set of selected broadcast events (see also col 1, lines 54 – 67).

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to use the "annotation file" of Gupta, but where the annotation database is made available to a broadcast receiver as per Kelly, with the motivation being Gupta's own disclosure of A public temporal annotation (Gupta, col 3, lines 4 – 16)—the Kelly viewer would then have the benefit of the additionally-authored

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bookmarks at the site of reception. As in the separate retention of content and annotations in Gupta, this would involve “transmitting to a viewing system the annotation file as a transmission that is distinct from the broadcast of the event”, and upon receipt of the annotation, a multimedia document player arrangement as per Gupta will “automatically display desired portions of the event”.

The Kelly bookmarking follows the selected broadcast event, and thus, any “annotation file” created as per Gupta will be “transmitted subsequent to the event” (claim 7).

Independent claim 18’s use of “an editor to automatically create an annotation file” reads upon the Gupta author’s creation of entries in the collection 420, this invariably involving automatic processes within the annotation database system. The use of “a first” and “second transmission medium” for the “presentation” and the “annotation file” is suggested by an extension to Kelly’s broadcast environment, when receiving the additional Gupta annotations.

Claim 20 is rejected using a line of reasoning similar to that presented for claim 5 above.

5. Applicant's arguments filed 6 December 2004 have been fully considered but they are not persuasive.

In arguing that “an annotation file” is now “automatically applied to automatically eliminate undesired portions of a broadcast or multimedia event” (remarks, pages 9, 10), applicant notes that in Gupta “a user may manually jump within the playback of a multimedia document to a particular time”. However, as noted in the rejection above,

the procession to a particular point in the Gupta presentation involves steps that are performed "automatically", and thus, the reference continues to anticipate or render obvious the claimed invention.

As per the secondary reference Kelly, applicant argues (pages 10, 11) that "Kelly et al. simply does not teach or suggest methods and systems which automatically apply annotation files". However, Kelly is relied upon to show broadcasts of bookmarked content, and not the automatic application of annotations, for which the reference used is Gupta.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

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8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



RAYMOND J. BAYERL  
PRIMARY EXAMINER  
ART UNIT 2173

2 March 2005